



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,103	10/05/2000	Douglas U. Mennie	47171-00271	3137

30223 7590 03/03/2003

JENKENS & GILCHRIST, P.C.
225 WEST WASHINGTON
SUITE 2600
CHICAGO, IL 60606

EXAMINER

SHAPIRO, JEFFERY A

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/684,103	MENNIE ET AL.
	Examiner Jeffrey A. Shapiro	Art Unit 3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) ____ is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7 and 11</u> .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, directed towards Claims 7-29, 78-89 and 146-149 in Paper No. 9 is acknowledged. The Examiner agrees with Applicants' request and will include Claims 58-77 in Group I.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7-29, 58-77, 78-89 and 146-149 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. Kobayashi et al discloses the following.

As described in Claims 7-29, 58-77, 78-89 and 146-149;

1. an input receptacle (1);
2. at least one output receptacle (note that the apparatus disgorges bills at the end of conveyor (5b));
3. a transport mechanism (5a and 5b);
4. a magnetic scanhead (H1 and H2) disposed adjacent to the transport path, the scanhead including a plurality of closely spaced magnetic sensors, each of the magnetic sensors being adapted to detect magnetic zone printing configuration information from each of the currency

bills, each of the magnetic sensors adapted to detect the presence of a security thread within each of the bills, the magnetic scanhead being adapted to determine a location of a detected security thread within a currency bill (see col. 7, lines 15-22 which indicates that magnetic pattern information is located on a bill in a pattern which can be identified by the system—note that at the very least, it would be inherent for a master pattern to be provided for comparison to the detected pattern of the currency, otherwise such a bill validator would not work);

5. a memory adapted to store master magnetic zone printing configuration information and master security thread location information (note that in order for the bill validator to work, it inherently must have memory, and that such memory can be adapted to store any required information);

6. an evaluation unit adapted to determine the denomination of each of the bills by comparing detected magnetic zone printing configuration information to the stored master magnetic zone printing configuration information, the evaluation unit being adapted to authenticate each of the currency bills by comparing the determined security thread location to the stored master security thread location information (note that the bill validator (note that the bill validator described by Kobayashi et al can easily be adapted to perform the functions as described in these limitations);

(Note that it is well-known to use magnetic currency threads, detect their pattern and location with magnetic scan heads, evaluate the data and compare such data with a set of master patterns, and then discriminate said currency based on such a comparison. See Mukai, for example, which discloses transport of currency (S204) past a magnetic sensor (12) (see col. 6, lines 45-60) and determining of the currency (s205) by comparing to stored data in a memory unit (16) (see figure 2).

Therefore, Claims 7-29, 58-77, 78-89 and 146-149 are rejected as being obvious over Kobayashi et al.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 7-29, 58-77, 78-89 and 146-149 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the Claims of each of the following U. S. Patent No.'s individually. They are;

5,295,196; 5,430,664; 5,467,405; 5,790,697; 5,790,697; 5,806,650; 5,815,592;
5,867,589; 5,870,487; 5,875,259; 5,905,810; 5,992,601; 6,012,565; 6,073,744;
6,220,419 B1; 6,237,739 B1; 6,241,069 B1; 6,278,795 B1; 6,311,819.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they either claim an apparatus that can perform the method, a method, or a combination of method and apparatus directed toward the following.

a method and apparatus for discriminating and counting currency bills including receiving a stack of bills, transporting the bills, counting and determining the denominations of the bills utilizing a detector, determining whether the bills fail or meet certain criteria, halting the transporting when a failing bill is identified, and placing the failed bill as the last bill in one of the output receptacles.

6. Claims 7-29, 58-77, 78-89 and 146-149 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 164-327 of both copending Application No.'s 09/541,170 and 09/542,487; Claims 157, 158 and 164-190 of copending Application No. 09/635,967; Claims 164-337 of copending Application No. 09/607,019; Claims 1-145 of copending Application No. 09/611,279; Claims of Application No. 09/126,580. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed toward the following.

a method and apparatus for discriminating and counting currency bills including receiving a stack of bills, transporting the bills, counting and determining the denominations of the bills utilizing a detector, determining whether the bills fail or meet certain criteria, halting the transporting when a failing bill is identified, and placing the failed bill as the last bill in one of the output receptacles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The Examiner notes that Application 09/864,423, which is commonly owned by the Applicants is currently unavailable to the Examiner for review of double patenting issues.

Response to Arguments

7. Applicant's arguments with respect to Claims 7-29, 58-77, 78-89 and 146-149 have been considered but are moot in view of the new ground(s) of rejection. See arguments above.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dames et al, Yoshihara, Winkler and Saffari et al are cited as examples of bill validators using magnetic scan heads to determine magnetic patterns in a bill, comparing that detected pattern with master data held in memory for classification purposes.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone numbers for the organization where this application or proceeding is assigned are (703)306-4195 for regular communications and (703)306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Jeffrey A. Shapiro
Patent Examiner,
Art Unit 3653



DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

February 25, 2003